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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/726,917

12/03/2003

Jose Abad Peiro

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EXAMINER

NGUYEN, MAIKHANH

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INTELLECTUAL PROPERTY ADMINISTRATION

FORT COLLINS, CO 80527-2400

ART UNIT

PAPER NUMBER

2176

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/726,917		PEIRO ET AL.	
	Examiner		Art Unit	
	Maikhanh Nguyen		2176	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/03/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communication: original application filed 12/03/2003; IDS filed 12/03/2003.
2. Claims 1-38 are currently pending in this application. Claims 1, 13, 17, 25 and 36 are independent claims.

Information Disclosure Statement

3. The Applicants' Information Disclosure Statements, filed December 03, 2003, has been received, entered into the record, and considered. See attached form PTO 1449.

Specification

4. Examiner requests that Applicant review the application carefully for informalities including typographical errors.

The cross reference related to the applications cited in the specification must be updated (i.e., update the relevant status, with PTO serial numbers or patent numbers where appropriate, on page 1). Correction is required.

Claim Objections

5. Claims 1-38 are objected to because of the following informalities: the abbreviations (*e.g., PDF, PPML, XML, and XSL*) used in these claims should be defined. Appropriate correction is required.

Drawings

6. The drawings filed on 3/12/2003 are accepted by the Examiner.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 8, "the macro file" lack antecedent basis.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The language of claims 17-35 raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result in a practical application producing a useful, concrete, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

Claims 17-35 are rejected under 35 U.S.C. 101 because the claims do not appear to require the use of computer hardware to implement the claimed invention.

Independent claims 17 and 25, do not appear to require any computer hardware to implement the claimed invention.

For example, independent claim 17 recites:

A system, comprising:

a variable object creation tool to select objects within a PDF document for designation as variable objects within a PPML template;

a macro selection tool to allow a user to select rules governing use of the variable objects; and

a PPML template generator to assemble the variable objects within the PPML template and to configure at least portions of the PDF document as a background within the PPML template and to assemble the selected rules as a macro.

These claims appear to define the metes and bounds of an invention comprised of software alone. There is no support (i.e., explicitly claimed computer hardware) in the body of claims 17 and 25 to support the “system” of the preamble. Likewise, the “system” of the preamble of claims 17 and 25 appears to be a system comprised entirely of software. Software alone, without a machine, is incapable of transforming any physical subject matter by chemical, electrical, or mechanical acts. (See “Interim Guidelines for Examination of Patent Applications for Patent Subject matter Eligibility”).

Dependent claims 18-24 and 26-35 are rejected for fully incorporating the deficiencies of their base claim.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 8-14, 17-21, 23-30, and 32-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kloosterman et al.** (US 2003/0189726, filed 04/09/2002).

As to claim 1:

Kloosterman teaches a processor-readable medium comprising processor-executable instructions for processing a PDF document to produce a PPML template [*see the Abstract and the discussion beginning at ¶¶ 0017 and 0109*], the processor-executable instructions comprising instructions for:

opening the PDF document (*e.g., open PDF*) [*see the discussion beginning at ¶ 0039*];

converting (*e.g., convert*) a PDF element (*e.g., text and graphics element*) within the PDF document into a variable object (*e.g., variable objects*) [*see the discussion beginning at ¶ 0039*];

selecting rules (*e.g., rules*) governing operation of the variable object [*see the discussions beginning at ¶¶ 0040 and 0107*]; and

configuring the PPML template (*e.g., template*) to include a definition of the variable object and a version of the PDF document *[see the discussions beginning at ¶¶ 0040 and 0107]*, wherein the version of the PDF document is configured as a background element within the PPML template (*e.g., creating a "Dynamic Imposition Template" and assigning the Dynamic Imposition Template to a PPML/VDX file. ...Since a Dynamic Imposition Template is a set of Static Imposition Templates, a Dynamic Imposition Template will have multiple layouts ... each Instance Document within a VDP Family will be imposed in accordance with a single Static Imposition Template similar to a standalone job*) *[see the discussions beginning at ¶ 0112]*.

Kloosterman does not specifically teach the use of a macro.

Kloosterman, however, teaches “*generates an Instance Document (a VDX file) ... applies the rules that were given by the author during the authoring process ... the PPML/VDX file is tested upon being opened to determine ... as specified by the Extensible Markup Language*” *[see the discussions beginning at ¶ 0039]*.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the teaching of Kloosterman to include a macro in the system of Kloosterman because it would have enhanced variable data printing practice within the printing industry and facilitate the production of Variable Data Printing Jobs.

As to claim 2:

Kloosterman providing a tool for operation by a user (*e.g., a tool that can be used by the prepress operator during prepress 20 to optimally manufacture the VDP print job as described from the job produce*; ¶ 0040) and responding to operations of the tool which result in a selection of a portion of the PDF document to be associated with the variable object (¶ 0050).

As to claim 3:

Kloosterman teaches selecting a graphical image (*e.g., graphics*) within the PDF document [*see the discussions beginning at* ¶ 0040].

As to claim 4:

Kloosterman teaches selecting text (*e.g., text*) within the PDF document [*see the discussions beginning at* ¶ 0040].

As to claim 5:

Kloosterman teaches providing the user with a first set of properties for graphical objects and a second set of properties for text objects; allowing the user to adjust the properties; and governing conversion of the PDF element within the PDF document into the variable object according to the properties (*e.g., creating templates to be used in variable data printing wherein a file is provided to a printing device containing parameters relative to*

a print job from which a plurality of categories are formed from parameters within the file. Production parameters are created for each of the categories within the categories. A list of manufacturing capabilities is obtained from the printing device) [see the discussions in ¶¶ 0019, 0033, and 0040].

As to claim 6:

Kloosterman teaches the use of an XML file (*e.g., XML (PPML) file*) and an XSL schema (*e.g., a schema*) [see the discussions in ¶ 0101]. Note the discussion of claim 1 above regarding to the use of macros.

As to claim 8:

Kloosterman teaches configuring the file to, among other things, regulate text scaling within the variable object (*e.g., the prepress 20 component will provide a set of tools to analyze, view, and prepare the VDP Job for the production 30. During production 30, the raster image processor (RIP) 32 will convert the code for each text and graphics element on every page into a format that can be printed by the print engine; ¶¶ 0040-0042*).

As to claim 9:

Kloosterman teaches modifying the PDF document to include marking elements to link the variable object with the file [see the discussions beginning at ¶ 0039].

As to claim 10:

Kloosterman teaches referencing the PDF document as a background PPML asset from within the PPML template; listing, within the PPML template, fonts required within the PPML template; configuring the PPML template to include at least one file; and defining the variable object as REUSABLE within the PPML template to allow reuse of the variable object when references indicating such use appear *[see the discussions in ¶¶ 0008, 0011, 0033, and 0054]*.

As to claim 11:

Kloosterman teaches saving the PPML template as an optimized tree-structure; and using a PPML to PDF converter to produce an optimized PDF document from the PPML template wherein subsequent instances of a PDF object will be substituted with references to an initial instance of the PDF object *[see the discussions in ¶¶ 0039-0043]*.

As to claim 12:

Kloosterman teaches presenting a user with a choice between .pplm and .ppmlt as an extension for addition to a file name; and saving a PPML document resulting from the PDF document under the file name with the extension *[see the discussions in ¶¶ 0031 and 0097-0099]*.

As to claim 13:

The rejection of claim 1 above is incorporated herein in full. Additionally, Kloosterman teaches marking a copy of the initial PDF document to indicate variable objects, thereby

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forming a marked PDF document (*e.g., supports standard Acrobat.RTM. bookmarks for identifying Instance Documents within Instance Documents ... supports pre-imposed views of PPML/VDX files within the network environment of the application ... supports pre-imposed and imposed sheet views of PPML/VDX files*) [see the discussions beginning at ¶ 0046].

As to claim 14:

Kloosterman teaches selecting text or an image, with a selection tool, to form the variable object; moving the variable object within the PDF document with a movement tool; and resizing the variable object with a resizing tool [see the discussions in ¶¶ 0040, 0098, 0108, and 0114].

As to claim 17:

The rejection of claim 1 above is incorporated herein in full. Additionally, Kloosterman teaches a variable object creation tool to select objects within a PDF document for designation as variable objects within a PPML template (*e.g., to enable the accurate and efficient manufacturing of the entire VDP Job as specified by the PPML/VDX file, the prepress 20 component will provide a set of tools to analyze, view, and prepare the VDP Job for the production 30*) [see the discussions beginning at ¶ 0040].

As to claim 18:

Note to the discussion of claim 4 above for rejection.

As to claims 19-21:

Note to the discussion of claims 3, 5, and 8, respectively, for rejections.

As to claim 23:

Note to the discussion of claim 6 above for rejection.

As to claim 24:

Kloosterman teaches a PPML to PDF converter to produce an optimized PDF document from a PPML document derived from the PPML template wherein subsequent instances of a PDF object will be substituted with references to an initial instance of the PDF object *[see the discussions beginning at ¶ 0040]*.

As to claims 25-30 and 33-35:

Note the rejection of claims 1-6 and 9-11 above. Claims 25-30 and 33-35 are the same as claims 1-6 and 9-11, except claims 25-30 and 33-35 are system claims and claims 1-6 and 9-11 are medium claims.

As to claim 32:

Kloosterman teaches rules for regulating text scaling within the variable object; rules for regulating text wrapping within the variable object; rules for regulating image scaling

within the variable object; and rules for regulating image cropping within the variable object (*e.g., see the rules discussion beginning at ¶ 0033*).

As to claim 36:

It is directed to a method for implementing the processor-readable medium of claim 13, and is similarly rejected under the same rationale.

As to claim 37:

Kloosterman teaches merging the PPML template with data, thereby creating a PPML document; and printing the PPML document using a digital press [*see the discussions in ¶ ¶0033-0039 and 043-0045*].

As to claim 38:

Note to the discussion of claim 2 above for rejection.

10. Claims 7, 15, 16, 22, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kloosterman et al.** in view of **De Bronkart**. “The PPML Print Language in XML Workflow for Digital Print” (21-25 May 201), pp. 1-5.

As to claim 7:

Kloosterman does not specifically the use of an external XSLT macro file.

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De Bronkart teaches the use of an external XSLT macro file (*e.g., XSLT*) [*see the discussion beginning at section 3.3*].

It would have been obvious to a person of ordinary skill in the art at the time of the invention was made to combine the teachings of De Bronkart with Kloosterman because De Bronkart's teachings would have provided the capability for converting data into different representations and facilitating the production of Variable Data Printing Jobs.

As to claims 15 and 16:

Note to the discussions of claims 7 and 8, respectively, for rejections.

As to claims 22 and 31:

Note to the discussion of claim 7 above for rejection.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

-	Parker et al.	U.S. Pat. No. 6,441,919	Issued: Aug. 27, 2002
-	Kueny	U.S. Pat. No. 6,547,831	Issued: Apr. 15, 2003
-	Warmus et al.	U.S. Pat. No. 6,844,940	Issued: Jan. 18, 2005
-	Kueny	U.S. Pat. No. 7,020,831	Issued: Mar. 28, 2006

- Hiebert U.S. Pub. No. 2003/0159105 A1 Pub. Date: Aug. 21, 2003
- Currans et al. U.S. Pub. No. 2003/0142334 A1 Pub. Date: Jul. 31, 2003
- Chao U.S. Pub. No. 2004/0004625 A1 Pub. Date: Jan. 8, 2004
- Boonen U.S. Pub. No. 2004/0083430 A1 Pub. Date: Apr. 29, 2004
- Dirk De Bosschere, "Book Ticket Files & imposition templates for variable data printing", Barco Graphics - Digital Printing Systems, March 2000, pp. 1-11.
- Anonymous, "PPML/VDX: Enabling variable-data printing", America Printer, October 2002, Vol.230, No. 1, pp. 44.
- "Introduction to the Personalized Print Markup Language: The PPML Family of XML Standards", PODi, July 2003, pp. 1-8.
- Bagley et al., "Creating Reusable Well-Structured PDF as a Sequence of Component Object Graphic 'COG' Elements", ACM, November 2003, pp. 58-66.

Contact information

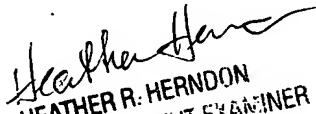
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached at (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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